IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

     Robert Marc Zeidman

Application No.: 09/767,819

Filed: January 22, 2001

U.S. Patent No. 8,316,390

Issue Date: November 20, 2012

For: METHOD FOR ADVERTISERS TO
     SPONSOR BROADCASTS WITHOUT
     COMMERCIALS

Confirmation No.: 9823

Art unit: 2623

Examiner: Schnurr, John R.

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.
/Laura Kirton/   January 18, 2013
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Commissioner for Patents
P.O. Box 1450
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REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705 (d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 2354 days to 3758 days is respectfully requested. In the alternative, Patentee requests that total PTA be increased from 2354 days to 2417 days.

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. "C Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(C), which guarantees or adjusts for delays due to interferences, secrecy orders, and appeals. Patentee respectfully submits that the Office did not apply the proper standard for determining the period of "B Delay" under 35 U.S.C. § 154(b)(1)(B).

<u>REVIEW OF PATENT TERM ADJUSTMENT CALCULATION</u>

<u>Applicant Delay</u>

A reply to an Office Action was due before November 13, 2004 (the day after the date that is three months from August 12, 2004, the date on which the Office Action was mailed). Patentee filed a non-responsive amendment on October 22, 2004, and then a fully responsive amendment on February 22, 2005, thereby according an Applicant Delay of 123 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from October 23, 2004 (the day after the date that the non-responsive amendment was mailed), to February 22, 2005. See 37 C.F.R. § 1.704(c)(7).

A reply to an Office Action was due before June 28, 2006 (the day after the date that is three months from March 27, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on July 10, 2006, thereby according an Applicant Delay of 13 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 28, 2006 (the day after the date that is three months from the date on which the Office Action was mailed), to July 10, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due before July 24, 2007 (the day after the date that is three months from April 23, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on July 25, 2007, thereby according an Applicant Delay of 2 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from July 24, 2007 (the day after the date that is three months from the date on which the Office Action was mailed), to July 25, 2007. See 37 C.F.R. § 1.704(b).

In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as <u>138 days</u> (i.e., the sum of 123 days, 13 days, and 2 days).

<u>"A Delay"</u>

A first PTO action was due before March 23, 2002 (the day after the date that is fourteen months from January 22, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on August 12, 2004, thereby according a PTO Delay of 874 days. Patentee does not dispute the PTO's calculation for this "A Delay" from March 23, 2002 (the day after the date that is fourteen months from the date on which the application was filed), to August 12, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due before June 23, 2005 (the day after the date that is four months from February 22, 2005, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on June 29, 2005, thereby according a PTO Delay of 7 days. Patentee does not dispute the PTO's calculation for this "A Delay" from June 23, 2005 (the day after the date that is four months from the date on which a response to Office Action was filed), to June 29, 2005. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as <u>881 days</u> (i.e., the sum of 874 days and 7 days).

"C Delay"

A notice of appeal to the Board of Patent Appeals and Interferences was filed on April 2, 2009 and a final decision in favor of the applicant by the Board of Patent Appeals and Interferences was issued on August 23, 2012, thereby according a PTO Delay of 1240 days. Patentee does not dispute the PTO's calculation for this "C Delay" from April 2, 2009 (the date on which the notice of appeal was filed), to August 23, 2012 (the date of the decision in favor of the applicant). See 37 C.F.R. §§ 1.702(e) and 1.703(e).

In view of the periods of "C Delay" detailed above, the total "C Delay" for this patent should be calculated as <u>1240 days</u>.

"B Delay"

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentee is entitled to "B Delay" to compensate for

that Office delay. The only issue in contention is the correct length of the "B Delay" period.

"B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. The period beginning on January 23, 2004 (the day after the date that is three years from the date on which the application was filed), and ending on November 20, 2012 (the date the patent was issued), is 3225 days in length. The "PTA 36 Months" entry in the PAIR/PALM system indicates that a total of 581 days were awarded for "B Delay" for this patent. The PTO excluded from "B Delay" the number of days corresponding to the period beginning on August 26, 2005 (the date on which a request for continued examination was filed) and ending on November 20, 2012 (the date the patent was issued). Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect.

Patentee respectfully contests the "B Delay" calculation on the following two alternative bases.

(i)   *Primary Argument: PTO erred by reducing PTA based on a request for continued examination filed after the 3-year "guaranteed" deadline*

According to the decisions in Exelixis, Inc. v. Kappos, No. 1:12-cv-96 (E.D. Va. November 1, 2012) and Novartis v. Kappos, No. 1:10-cv-01138 (D.D.C. November 15, 2012), a Request for Continued Examination operates to toll the three year "guaranteed" deadline of 35 U.S.C. § 154(b)(1)(B) only if it is filed within three years of the application filing date. If filed after the three year deadline has passed, a Request for Continued Examination has no impact on PTA.

For the present patent, no Request for Continued Examination was filed during the first three years of application pendency. The Request for Continued Examination filed on August 26, 2005, therefore does not operate to reduce the "B Delay" award. As a result, the patent is entitled to 3225 days of "B Delay", measured from January 23, 2004 (the day after the date that is three years from the date on which the application was filed) to November 20, 2012 (the date the patent was issued).

(ii)   *Secondary Argument: PTO erred by counting the time between the notice of allowance and the patent issue date as "time consumed by continued examination of the application"*

This subsection presents an alternative calculation of "B Delay" in the event that the argument in subsection (i) above is deemed unpersuasive.

The Examiner's mailing of a Notice of Allowance on September 19, 2012, closed examination of the application on that date. Section 154(b)(1)(B)(i) of Title 35 excludes from "B Delay" "time consumed by continued examination of the application." The statute does not provide for exclusion from "B Delay" of time from the mailing of a Notice of Allowance until issuance (a period during which examination is closed and continued examination does not occur). Thus, no continued examination took place during the 63 day period from September 19, 2012 (the mailing date of the Notice of Allowance) until November 20, 2012 (the date the patent was issued). Accordingly, 63 days of "B Delay" should have been included in addition to the 581 days accorded by the Director, for a total "B Delay" of <u>644 days</u>.

Overlap of "A Delay" and "C Delay" with "B Delay"

To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). In view of the remarks above, the period of overlap of "A Delay" and "C Delay" with "B Delay" should be calculated as follows. The primary argument below is based on the "B Delay" presented in subsection (i) above. The secondary argument below is based on the "B Delay" presented in subsection (ii) above.

(i)   *Primary Argument: PTO erred by reducing PTA based on a request for continued examination filed after the 3-year "guaranteed" deadline*

As detailed above, 881 days of "A Delay" accumulated during the following periods:

March 23, 2002, to August 12, 2004; and

June 23, 2005, to June 29, 2005.

As detailed above, 1240 days of "C Delay" accumulated during the following period:

April 2, 2009, to August 23, 2012.

As detailed above, 3225 days of "B Delay" accumulated during the following period:

January 23, 2004, to November 20, 2012.

As such, the periods of "A Delay" and "C Delay" overlap with "B Delay" (i.e., occur on the same calendar day) for 203 days, from January 23, 2004, to August 12, 2004; 7 days, from June 23, 2005, to June 29, 2005; and 1240 days, from April 2, 2009, to August 23, 2012 for a total of 1450 days of overlap.

(ii)   *Secondary Argument: PTO erred by counting the time between the notice of allowance and the patent issue date as "time consumed by continued examination of the application"*

As detailed above, 881 days of "A Delay" accumulated during the following periods:

March 23, 2002, to August 12, 2004; and

June 23, 2005, to June 29, 2005.

As detailed above, 1240 days of "C Delay" accumulated during the following period:

April 2, 2009, to August 23, 2012.

As detailed above, 644 days of "B Delay" accumulated during the following periods:

January 23, 2004, to August 26, 2005; and

September 19, 2012, to November 20, 2012.

As such, the periods of "A Delay" and "C Delay" overlap with "B Delay" (i.e., occur on the same calendar day) for 203 days, from January 23, 2004, to August 12, 2004; and 7 days, from June 23, 2005, to June 29, 2005 for a total of 210 days of overlap.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 2354 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following alternative manners. The primary argument below is based on the "B Delay" presented in subsection (i) above. The secondary argument below is based on the "B Delay" presented in subsection (ii) above.

(i) *Primary Argument: PTO erred by reducing PTA based on a request for continued examination filed after the 3-year "guaranteed" deadline*

1)   Total PTO Delay should be calculated as 3896 days (i.e., the sum of 881 days of "A Delay," 1240 days of "C Delay," and 3225 days of "B Delay" minus 1450 days of overlap);

2)   Total Applicant Delay should be calculated as 138 days; and

3)   Total PTA should be calculated as 3758 days.

(ii) *Secondary Argument: PTO erred by counting the time between the notice of allowance and the patent issue date as "time consumed by continued examination of the application"*

1)   Total PTO Delay should be calculated as 2555 days (i.e., the sum of 881 days of "A Delay," 1240 days of "C Delay," and 644 days of "B Delay" minus 210 days of overlap);

2)   Total Applicant Delay should be calculated as 138 days; and

3)   Total PTA should be calculated as 2417 days.

The fee of $200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. If there are any additional charges, please charge them to Deposit Account No.: 50-1358.

Respectfully submitted,

LOWENSTEIN SANDLER LLP

Date: January 18, 2013   /Garrett R. Miedema/

Garrett Miedema

Reg. No. 61,938

390 Lytton Avenue
Palo Alto, CA 94301
(650) 433-5714